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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/506,294 | 08/31/2004 | Johannes Lenkl | 53376/DBP/E43 | 3215 |
| 23363 7590 05/24/2007 CHRISTIE, PARKER & HALE, LLP PO BOX 7068 PASADENA, CA 91109-7068 | | | EXAMINER OSELE, MARK A | |
| | | | ART UNIT 1734 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/506,294 | Applicant(s) LENKL, JOHANNES | |
| | Examiner Mark A. Osele | Art Unit 1734 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The claim states the applicator head is configured to be reversible" and "the applicator pad can be reversibly inserted into a pad receiving means." Upon review of the application, similar language was discovered in the "Summary" portion of the application, but there is no description of this feature in sufficient detail to ascertain the scope and meaning of the claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7-9, 13-18 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 7-9 are indefinite because it is not clear what is meant by "the applicator head is configured to be reversible" and "the applicator pad can be reversibly inserted into a pad receiving means." These phrases could mean that the applicator head could move to label objects both above and below the applicator head or could move upward and downward. Similarly the pad receiving means could go in and out, or could go in with either side up.

6. Claim 13 line 2 includes the limitation that the applicator pad "is formed from a carrier plate an applicator plate." The phrase, "an applicator plate" is confusing and does not appear to belong in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 6, 13, 16-17, and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by French (US Patent No. 3,888,725).

Regarding claim 1, French discloses an applicator head for a device which is in communication with an air suction source and also includes an applicator surface, 67, with at least two perforatable, weak locations being recesses, 101, having a bottom,

Art Unit: 1734

115, which can be perforated, 117, by a suitable tool. (Col. 5, lines 32-36, 54-67, Col. 6, lines 18-25)

As to claims 2, 3, and 5, Figures 3 and 5 show how the weak locations are regularly arranged over the entire applicator surface in rows and columns.

As to claim 4, Figure 3 shows grooves on the outside of the applicator surface.

As to claims 6 and 13, French further shows an applicator pad, 31, coupled to the applicator surface. (See Figure 4) Also included is a mounting frame releasably connected to the applicator pad (See Figure 2).

As to claim 16, the applicator plate in French adapts the applicator surface to the flat material element.

As to claim 17, the carrier plate is releasably connected to the air suction force through tubes, 103.

As to claim 19 and 20, the formation in Figures 3 and 5 show a pattern of closely spaced dots that amounts to a raster grid with rows and columns.

As to claim 21, the grooves extend in parallel and at equidistant spacing to each other.

As to claim 22, the applicator plate includes an applicator surface in French.

As to claim 23, the carrier plate and applicator plate in Figure 4 includes a space in between.

9. Claims 1-5, 13, 15, 18, 21, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker (US Patent No. 6,182,957 B1).

Regarding claim 1, Becker discloses an apparatus for holding a flexible product which is in communication with an air suction source and also includes an applicator surface with at least two perforatable, weak locations being recesses having a bottom which can be perforated by a tool which is made of a harder material than the plate.

As to claims 2 and 3, Figure 3 shows how the weak locations are regularly arranged over the entire applicator surface.

As to claims 4, 5, and 21, a second plate (16) is fastened to the flat plate (14) and provides for columns and grooves which are provided between at least two columns of the weak locations as shown in Figure 1. The grooves extend in parallel and at equidistant spacing to each other.

As to claim 13, Becker includes an applicator plate (16) and a carrier plate (14).

As to claim 15, the applicator plate includes grooves which are considered weakened locations which are aligned with the weakened locations (22) on the carrier plate (14).

As to claims 18 and 26, the material used in Becker is plastic material, and plastic materials are known to be deformable.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4, 6, 10, 13, 15-17, 19, 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hofe (US Patent No. 2,492,908). In view of Becker (US Patent No. 6,182,957).

Regarding claim 1, Von Hofe discloses an applicator head for a device which is in communication with an air suction source and also includes at least two perforatable, weak locations on the surface. The applicator in Von Hofe includes a shim (45). (Col. 5, line 51 through Col. 6, line 27.) Von Hofe fails to show the weak locations being recesses.

Becker shows weak locations being recesses having a bottom that can be perforated by a suitable tool. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the weak locations of Von Hofe in recesses, such as those shown by Becker, because vacuum surfaces commonly include recesses so an adhered article can remain supported on raised ridges while vacuum is applied along the recesses.

As to claims 2 and 3, Figures 3 and 5 of Von Hofe show how the weak locations are regularly arranged over the entire applicator surface.

As to claim 4, Figure 6 of Von Hofe shows grooves on the outside of the applicator surface.

As to claims 6, 10, 13, and 15, Von Hofe includes an embodiment where an applicator pad (39) is coupled to the applicator surface of the shim (41). (See Figure 2.) Also included is a mounting frame (36) releasably connected to the applicator pad (39).

Art Unit: 1734

The surface of the mounting frame includes perforated or weak locations (42) which correspond to the ones on the shim (41).

As to claim 16, the carrier plate in Von Hofe has a sufficient thickness.

As to claim 17, the carrier plate of Von Hofe is releasably connected to the air suction force.

As to claim 19 and 20, the formation in Figures 3 and 5 of Von Hofe show a pattern of closely spaced dots that amounts to a raster grid with rows and columns.

As to claim 22, the applicator plate of Von Hofe includes an applicator surface in Van Hofe.

As to claim 23, the embodiment of Von Hofe with the carrier plate and applicator plate in Figure 2 includes a space in between.

12. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hofe in view of Becker as applied to claims 1, 6, and 10 above, and further in view of Tiefel (US Patent No. 5,885,406).

While Von Hofe shows applicator pad with a mounting frame, there is no teaching in Von Hofe with respect to a locking device which includes a spring-loaded ball. It would have been obvious to one having ordinary skill in the art at the time the invention was made that such a locking device could be used in the device of the references as combined, because, as shown in Tiefel, such a locking device is known in the art and within the purview of one of ordinary skill to use as needed.

Art Unit: 1734

13. Claims 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hofe in view of Becker as applied to claims 1 and 13 above, and further in view of Wood (US Patent No. 3,377,096) or Wilson et al. (US Patent No. 5,024,574).

Von Hofe discloses releasably attaching the applicator plate and the carrier plate. Alternatively the plates could be non-releasably fastened together as shown in both Wood and Wilson. It would have been obvious to one having ordinary skill in the art at the time the invention was made to non-releasably fasten plates together by means of glue, because Wood and Wilson show that it is well known to glue surfaces together which multiple plates are used in combination on a vacuum chuck. Using glue to adhere the plates together is a functionally equivalent alternative expedient of using fasteners, both being within the purview of the artisan.

Allowable Subject Matter

14. Claim 25 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments filed September 13, 2006 have been fully considered but they are not persuasive. Becker shows the new limitation of the recesses. The newly cited reference to French also shows this limitation.

Conclusion

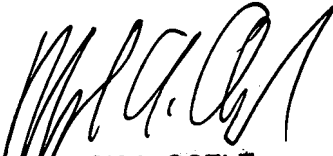
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Taylor and Baumli each show applicator heads with a plurality of areas which can be perforated to make vacuum through holes.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MARK A. OSELE
PRIMARY EXAMINER

May 22, 2007